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APPLICATION NO. 09/272,455	FILING DATE 08/10/99	FIRST NAMED INVENTOR IRUELA-ARISPE	ATTORNEY DOCKET NO. 1448.1070006
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EXAMINER JOHNSON, N

ART UNIT 1642	PAPER NUMBER 7
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DATE MAILED: 07/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/373,658

Applicant(s)
Iruela-Arispe

Examiner
Nancy Johnson

Group Art Unit
1642



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-23 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-23 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a polynucleotide encoding the METH1 protein (SEQ ID NO:2), classified in class 536, subclass 23.1.
 - II. Claims 8-14, drawn to a polynucleotide encoding the METH2 protein (SEQ ID NO:4), classified in class 536, subclass 23.1.
 - III. Claims 15 and 17, drawn to the METH1 polypeptide (SEQ ID NO:2), classified in class 530, subclass 350.
 - IV. Claims 16 and 18, drawn to the METH2 polypeptide, classified in class 530, subclass 350.
 - V. Claims 19-23, drawn to a method of inhibiting angiogenesis comprising the administration of the METH1 polypeptide, classified in class 514, subclass 44. Claims 19-23 will be examined with Group V to the extent that they read on a method comprising the administration of the METH1 polypeptide product.
 - VI. Claims 19-23, drawn to a method of inhibiting angiogenesis comprising the administration of the METH2 polypeptide, classified in class 514, subclass 44. Claims 19-23 will be examined with Group VI to the extent that they read on a method comprising the administration of a METH2 polypeptide product.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-IV are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups V and VI differ in the reagents used.

Inventions III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

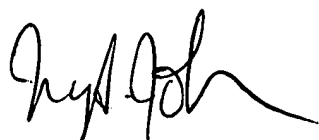
as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the METH1 polypeptide can be used as an immunogen in the production of antibodies.

Inventions IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the METH2 polypeptide can be used as an immunogen in the production of antibodies.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Johnson whose telephone number is (703) 305-5860.



NANCY A. JOHNSON, PH.D
PRIMARY EXAMINER

June 27, 2000